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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,189	07/24/2001	Steven N. Terranova	2400-171A	8221

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EXAMINER

BANGACHON, WILLIAM L

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/912,189

Applicant(s)

TERRANOVA, STEVEN N.

Examiner

William Bangachon

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TV

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6-10,13-28 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-10,13-28 and 34-36 is/are rejected.
- 7) ☒ Claim(s) 1-3,9,10 and 17-119 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Examiner's Response*

1. In response to the application filed 24 July 2001, the application has been examined. The Examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. It is the Examiner's position that claims 1-3, 6-10, 13-28, and 34-36 are unpatentable for the reasons set forth in this Office action:

### *Claim Objections*

2. Claims 1-3, 9-10, 17-19, and 21-24 are objected to because of the following informalities: It is noted that the term "**adapted to**" (claim 1, lines 4 & 9; claim 2, line 3; claim 3, line 3; claim 9, line 2; claim 10, line 2; claim 17, line 1; claim 18, line 1; claim 19, line 1; claim 21, line 1; claim 22, line 1; claim 23, line 1; and claim 24, line 1) has been used in the claims. It has been held that the recitation that an element is "**adapted to**" performing an action is not a positive limitation but only requires the ability to do so. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Appropriate correction is required.

3. Claims 17-18 and 21-22 are objected to because of the following informalities: The phrase "adapted cause said means" is incomplete. Appropriate correction is required.

### ***Specification***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The language should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. In this case, the abstract uses the phrase "The present invention ..." (line 3).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 6-8 and 16-19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3 and 34-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S.

Patent No. 6098879 (will be referred to as patent 879) or U.S. Patent No. 6422464 (will be referred to as patent 464). Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons;

In claims 1 and 3, patent 879 and 464 claims a system for automatically providing customer preferences during a fueling transaction comprising; wireless communications electronics associated with a fuel dispenser; a customer interface analogous to the claimed transaction interface; a control system and memory associated with communications electronics; and said control system adapted to receive from a customer remote communication unit and automatically provide the customer with select information at said customer interface {patent 879, col. 45, line 56-col. 46, line 7; patent 464, col. 46, lines 4-20} or said control system prevents presentment of select information at said customer interface {patent 879 col. 47, lines 14-34; patent 464, col. 47, lines 27-47}. The claims in patent 879 or 464 are narrower than the claims of the current application. Obviously, the narrower claims reads on the broader claim recitation of the current application. Therefore, it would have been obvious to one of ordinary skill that the claims of the current application and the claims of patent 879 or 464 are not patentably distinct from each other because the narrower claims of patent 879 or 464 reads on the broader claims of the current application.

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Claim 2 recites the claim limitations of claim 6 or 25 of patents 879 and 464. Claims 34-36 is a method for practicing the apparatus of claims 1-3 and is an obvious variation of claims 31-33 of patents 879 and 464 to one of ordinary skill in the art because claims 31-33 of patents 879 and 464 are narrower than claims 34-36.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-3, 9-10, 13-26 and 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,072,380 (Randelman et al).

Regarding claims 1-3 and 9-10, Randelman et al teaches a system for providing transaction parameters in association with a remote communication unit {see whole document} which comprises a wireless communication electronics (figures 1 and 2) adapted to receive signals including indicia/vehicle identity from remote communication units (8) {col. 2, lines 16-29}; a transaction interface for carry out transactions {col. 4, lines 19-25}; a control system and memory associated with said communication electronics and said transaction interface {col. 3, lines 13-29}; and said control system adapted to receive the indicia from a remote communication unit and control a transaction at the transaction interface involving the remote communication unit according to predefined parameters defining a limitation or guideline for the transaction associated with the remote communication unit {col. 1, line 26-col. 2, line 2; col. 4, lines 19-65}.

In claims 13, 14, 15, the system of claim 1 wherein said control system is connected to a network having said memory containing the predefined parameters {col. 5, lines 18-29}.

In claims 16-19, the system of claim 1 further comprising means for alerting a customer of a predefined parameter associated with said control system; wherein said control system is adapted cause said means to alert the customer when a predefined parameter is reached during a transaction; wherein said control system is adapted to cause said means to alert the customer that a predefined parameter exists; wherein said control system is adapted to monitor a transaction for actions violating the predefined parameters and cause said means to alert the customer of an action violating the predefined parameters {col. 4, lines 60-65; paragraph bridging cols. 5 and 6}.

In claims 20-24, the system of claim 1 further comprising means for alerting an operator of a predefined parameter associated with said control system; wherein said control system is adapted to cause said means to alert the operator when a predefined parameter is reached during a transaction; wherein said control system is adapted cause said means to alert the operator that a predefined parameter exists; wherein said control system is adapted to monitor a transaction for actions violating the predefined parameters and cause said means to alert the operator of an action violating the predefined parameters {col. 4, lines 14-19 and lines 44-51; col. 5, lines 18-29}

In claims 25-26, said means is display {col. 7, lines 21-32}.



Claims 34-36 are directed to a method for enforcing the system of claim 1 and its independent claims and therefore rejected for the same reasons.

12. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,072,380 (Randelman et al).

With regards to claims 6-8, although Randelman does not disclose expressly "the predefined parameters limit a transaction to a purchase amount and control a transaction by preventing purchase of select product", these claim limitations would have been obvious in the system of Randelman, to one of ordinary skill in the art {col. 4, lines 19-59; col. 7, lines 32-52}. The remote communication units (8) are cross checked for credit or other billing information as soon as it is determined that the remote communication unit is a valid customer {col. 4, lines 40-42}. The remote communication units provide accounting record containing all data needed for billing, discounts, and **authorized purchases or products** {col. 5, lines 62-65}. Clearly, this implies that the control system can limit a transaction to a purchase amount (**authorized purchases**) and/or control a transaction by preventing purchase of select products (**authorized products**). Limiting a purchase or product is provided in the CPF which stores customer preferred product choices, service appointment times, accounting, or payment methods {col. 6, lines 6-8}. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to "limit a transaction to a purchase amount

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and control a transaction by preventing purchase of select product" as claimed, in the system of Randelman, as described above, to one of ordinary skill in the art.

13. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,072,380 (Randelman et al) in view of US 5,798,931 (Kaehler).

In claims 27-28, Randelman does not disclose said means is an audio system and speaker. These claim limitations are conventional and widely used in gas stations. Most if not all gas stations that are open 24 hours use audio system and speaker to communicate with their customers, especially at night, for fear of theft/hold-up wherein the doors are locked, with just the attendant inside the store. Clearly, having an audio system and speaker in the system of Randelman is beneficial in avoiding theft/holdup. An example of such a system would be the operator intercom system of Kaehler. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have an audio system and speaker in the system of Randelman because this provides deterrence to theft or holdup.

***Examiner Contact Information***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/10.

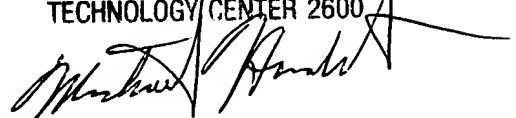
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314 for regular and After Final formal communications. The examiner's fax number is 703-746-6071 for informal communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

William L Bangachon  
Examiner  
Art Unit 2635

January 15, 2003

MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Michael Horabik', is written over the printed name and title.